

REMARKS

A. Introduction

Claims 1-26 are pending and under consideration in the application.

In the Office Action of July 26, 2007 claims 1-7, 10-20, and 23-26 were rejected as obvious. Claims 8, 9, 21, and 22 were indicated as allowable if rewritten in independent form.

In response, no claims have been amended, the scope of the original claims has not been altered, and no new matter is presented.

B. Rejection under 35 USC §103

Claims 1 and 14 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Ito (JP 2002-237088) in view of Nobuaki (JP 2002-074747). Applicants traverse these rejections for at least the following reasons.

While the Examiner relies on paragraph 25 of Ito in attempt to demonstrate that Ito teaches all of the limitations recited in independent claims 1 and 14, the Examiner acknowledges that Ito does teach upper and lower dielectric layers, as recited in independent claims 1 and 14. The Examiner, however, relies on paragraphs 28 and 29 of Nobuaki and concludes that "Nobuaki makes it well known and obvious that the lower and upper dielectric layers in Ito would have implied and necessitated a lower dielectrics layer including a first lower dielectrics layer and a second lower dielectrics layer that inhibits a material that constitutes the first lower dielectrics layer and a material that constitutes the reflective layer from reacting; and the upper dielectrics layer includes a first upper dielectrics layer and a second upper dielectrics layer that inhibits a material that constitutes the first upper dielectrics layer and a material that constitutes the light transmissive layer from reacting as claimed." However, neither Ito nor Nobuaki, either individually or combined, disclose the Applicants' invention as recited in independent claims 1 and 14.

First, the paragraph relied on in Ito describes a transparent substrate having the following successive layers: a first dielectric layer, a phase change recording layer, and a second dielectric layer. See Ito, para. 25. This is not the same as "a reflective layer, a lower dielectrics layer, a recording layer, an upper dielectrics layer, and a light transmissive layer that are

sequentially laminated on one main surface of a substrate,” as recited in independent claims 1 and 14.

Second, the Examiner does not appear to give any weight to the following limitations: “wherein light having a wavelength in the range of 400 nm or more and 410 nm or less is focused with an optical system having a numeral aperture in the range of 0.84 or more and 0.86 or less followed by irradiating from a side of the light transmissive layer on the recording layer, and thereby an information signal is recorded and produced,” as recited in independent claims 1 and 14. While the Examiner argues that paragraph 25 of Ito teaches all of these limitations, it is clear from a reading of paragraph 25 that Ito does not disclose these limitations and is deficient.

Furthermore, the limitations of claims 1 and 14 not present in Ito are also not taught or suggested by Nobuaki. The Examiner relies on Nobuaki only to assert that it teaches the lower and upper dielectric layers, as recited in claims 1 and 14. See Office Action, page 3. However, because Nobuaki also does not teach or suggest the features which are lacking in Ito, including, “a reflective layer, a lower dielectrics layer, a recording layer, an upper dielectrics layer, and a light transmissive layer that are sequentially laminated on one main surface of a substrate,” or “wherein light having a wavelength in the range of 400 nm or more and 410 nm or less is focused with an optical system having a numeral aperture in the range of 0.84 or more and 0.86 or less followed by irradiating from a side of the light transmissive layer on the recording layer, and thereby an information signal is recorded and produced,” as recited in independent claims 1 and 14, these claims are allowable over Ito and Nobuaki, separately or in combination.

In addition to the above deficiencies, the Examiner does not provide any motivation to combine Nobuaki with Ito. In fact, the Examiner merely states that “Nobuaki makes it well known and obvious that the lower and upper dielectric layers in Ito would have implied and necessitated,” and then essentially recites the limitations within claims 1 and 14. The Examiner then points to Nobuaki, paras. 28 and 29. Clearly, the Examiner’s statements do not provide any motivation to combine Nobuaki with Ito.

Therefore, neither Ito nor Nobuaki, either individually or combined, teach or suggest all of the limitations recited in claims 1 and 14, and Applicants respectfully submit that the Examiner has not met the burden of establishing a prima facie case of obviousness as set forth in MPEP § 2142, portions of which are cited as follows:

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“The Examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness...

...To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).”

Accordingly, for at least the reasons above, Applicants submit that independent claims 1 and 14 are allowable over Ito nor Nobuaki, either individually or combined, and withdrawal of these rejections and allowance of these claims are respectfully solicited. Likewise, claims 2-13 and 15-26 respectively depend from independent claims 1 and 14 and thus includes all of the limitations of independent claims 1 and 14. Accordingly, dependent claims 2-13 and 15-26 are allowable over Ito nor Nobuaki, either individually or combined, for at least the same reasons discussed above with respect to claims 1 and 14. In addition, claims 2-13 and 15-26 are patentable over Ito and Nobuaki, either individually or combined, for their own limitations as well as for respectively depending from claims 1 and 14.

Regarding claims 2-13 and 15-26, the Examiner attempts to reject the limitations recited in these claims by merely alleging that “Ito and Nobuaki in combination further teach [the limitations within claims 2-13 and 15-26].” At no point, however, does the Examiner attempt to provide any motivation to combine Ito and Nobuaki. As such, the Examiner has not met the burden of proof required to support a conclusion of obviousness and the rejections are fatally flawed. Clearly, the Examiner is using impermissible hindsight.

When applying 35 U.S.C. 103, the following tenets of patent law must be adhered to:

- (A) The claimed invention must be considered as a whole;
- (B) The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination;
- (C) The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and
- (D) Reasonable expectation of success is the standard with which obviousness is determined.

Hodosh v. Block Drug Co., Inc., 786 F.2d 1136, 1143 n.5, 229 USPQ 182, 187 n.5 (Fed. Cir. 1986). (Emphasis added).

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Accordingly, neither Ito nor Nobuaki, either individually or in combination, meet all of the limitations recited in claims 1-26. Therefore, the rejections of claims 1-26 under 35 U.S.C. §103(a) are improper, and withdrawal of these rejections and allowance of these claims are earnestly solicited.

C. Conclusion

In view of the foregoing, it is submitted that claims 1-26 are allowable and that the application is in condition for allowance. Notice to that effect is requested.

If any further fees are required in connection with the filing of this amendment, please charge the same to our Deposit Account No. 19-3140.

Respectfully submitted,
SONNENSCHN NATH & ROSENTHAL LLP

By /Adam C. Rehm/
Adam C. Rehm, Reg. No. 54,797
P.O. Box 061080
Wacker Drive Station, Sears Tower
Chicago, IL 60606-1080
816-460-2542 (telephone)
312-876-7934 (facsimile)

ATTORNEYS FOR APPLICANT